REMARKS/ARGUMENTS

The rejections presented in the Office Action dated June 2, 2005 (hereinafter Office Action) have been considered. Claims 1-35 remain pending in the application. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

The Claims 13-25 were objected to because of formalities. Applicants respectfully traverse the objections. However, in order to facilitate prosecution of the application, Applicants have amended Claims 13, 15, 22, and 24 as suggested in the Office Action. Applicants' respectfully request withdrawal of the objections to Claims 13-25 in view of the aforementioned amendments that were made to address the objections. The amendments made to the claims are not made for purposes relating to patentability, and are not made in response to prior art or any objections or rejections to the claims. Thus, the Applicants have not intended to narrow, nor have the Applicants narrowed, the scope of any of the claims resulting from the aforementioned amendments.

Claims 1-4, 6-29, and 31-35 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2002/0037723 to *Roach*. Applicants respectfully traverse the rejection. To anticipate a claim the reference must teach every element of the claim, and it is respectfully submitted that *Roach* does not meet this standard.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131, quoting *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the patent claim; *i.e.* every element of the claimed invention must be literally present, arranged as in the claim." MPEP 2131, quoting *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Applicants first submit that *Roach* does not teach every element of independent Claims 1, 15, 26, 31, and 35, and therefore fails to anticipate these claims. Independent Claims 1, 31, and 35 involve creating routing instructions for routing incoming communication requests based on presence information. Independent Claim 15 involves creating a routing script at an S-CSCF based on user presence information. Independent Claim 26 involves converting user presence information to routing instructions. Controlling routing based on user presence information allows, among other things, a user to control routing of messages by changing the user's presence information (see, e.g., p. 13, lines 18-22 of the Applicants' Specification). As to these independent claims, *Roach* at least fails to teach or otherwise disclose using user presence information to create routing instructions or routing scripts.

Roach generally discloses a procedure for "updating service profile information ... between two nodes interconnected by an IP (Internet Protocol) network using existing IETF protocols after initial registration has been performed." (para 0097). *Roach* describes a CI host, which *Roach* states is equivalent the S-CSCF as defined in 3GGP specifications (para. 0056). The CI host "is the host for the execution of call states" and performs tasks such as downloading subscriber profile and tracking the user's location during a call. (para 0064). *Roach* does not describe "presence information" at all, but discusses a "service profile" that is provided to the CI host at SIP registration. (para. 214). Applicants submit that the service profile is different than user presence information.

Roach describes the service profile as containing "service parameters or triggers." (para. 0097). A more useful definition is provided in *Supporting Service Mobility with SIP (IEFT Internet Draft draft-itsumo-sip-mobility-service-00.txt)*, which states "the service profile contains [a] list of all subscribed services as well as any other service related information (e.g., balance of a user's account for a pre-paid service), etc." In contrast, as is known in the relevant art, presence information relates to "times, locations, and/or

situations where [users] are, or are not, willing or able to accept incoming communications." (p. 2, lines 1-2 of the Applicants' Specification). Therefore, the service profiles described in *Roach* not properly characterized as user presence information.

Notwithstanding the arguments above that the service profiles are different than user presence information, *Roach* does not even describe using the service profile for routing requests from the CI host. *Roach* only describes the service information as being used for "executing or triggering services." (para. 0101). *Roach* is silent as to the uses of the service profile for routing because *Roach* is only concerned with mechanisms that update the service profile after the initial registration (paras. 0099 – 0100).

In *Roach*, the only data described for routing messages is the Contact header of a SIP REGISTER request received at the CI host. For example, "[t]he CI host will create a local record of where it should forward messages intended for the user, derived from the Contact header." (para. 0087). As seen in *Roach*'s example SIP REGISTER message in paras. 0155-0165 and HTTP profile download in paras 0174-0189, the service profile is part of an entirely separate transaction from the SIP REGISTER message. In particular, the Contact header is shown in para. 0160 of the SIP REGISTER message, and the service profile is shown in paras. 0181-0189 in the HTTP document download request. Therefore, *Roach* merely describes the standard method of routing requests to a user based on the Contact header of a SIP REGISTER request. *Roach* is silent as to any use for the service profile related to routing.

In contrast, the Applicants' invention as set forth in independent Claims 1, 15, 26, 31, and 35 utilizes the user's presence information to create routing instructions or scripts. For example, in Applicants' FIGS. 7A and 7B, example scripts are shown that used to route incoming connections to various destinations based on presence information. *Roach* entirely fails to recognize this use of presence information to route incoming connections, and as such *Roach* cannot anticipate Applicants' Claims 1, 15, 26, 31, and 35. Therefore,

Applicants respectfully submit that Claims 1, 15, 26, 31, and 35 are in condition for allowance.

As to dependent Claims 9-12, 19-25, and 34, the Office Action has failed to substantively address the features of these claims. In addition to the features recited in independent Claims 1, 15, and 31 from which these claims respectively depend, Claims 9-12, 19-25, and 34 also involve publishing presence information. Nowhere in the Office Action do the Applicants' see reference to the publication of presence information, and Applicants' respectfully submit that the §102 rejection cannot be maintained without a showing that *Roach* literally presents "every element of the claimed invention ..., arranged as in the claim." *Richardson.* Therefore Applicants submit that Claims 91-12, 19-25, and 34 are further allowable over *Roach.*

Roach also fails to anticipate dependent Claims 4 and 29. Claims 4 and 29 contain features directed to creating routing scripts based on the presence information. The Office Action relies on page 8 of *Roach* to show these feature. However, Applicants respectfully point out that on page 8, *Roach* only provides example network messages, including a SIP Redirect, SIP REGISTER, and HTTP GET, and HTTP responses. The term "script" as it is used in the computer sciences and related arts relates to a data object that contains executable instructions, and would therefore not include SIP and HTTP messages. There is nothing in the format of the network messages shown on p. 8 or *Roach*, or elsewhere described in *Roach*, that would suggest the messages contain instructions that would make the messages usable as scripts. Therefore, Applicants respectfully submit that *Roach* fails to teach this feature, and Claims 4 and 29 are allowable for this additional reason.

Roach also fails to anticipate dependent Claims 6 and 21. Claims 6 and 21 include features related to receiving notification of changes in the state of presence. In paragraph 0216 of *Roach* relied upon in the Office Action, *Roach* merely describes the CI actively checking for change information by using the HTTP HEAD method to determine the "Last

Modified" date of the service profile. First, as described in greater detail above, the service profile is different that presence information. Secondly, the "polling" of data by the CI is different than receiving notifications. Notifications are initiated by another entity, while the updates described in *Roach* are initiated by the CI server itself. Therefore, Applicants respectfully submit that Claims 6 and 21 are further allowable over *Roach.*

In addition to the reasons given above, Applicants also notes that dependent Claims 2-5 and 6-14 ultimately depend from independent Claim 1; dependent Claims 16-25 ultimately depend from independent Claim 15; Claims 27-29 ultimately depend from independent Claim 26; and dependent Claims 32-34 ultimately depend from independent Claim 31. These dependent claims also stand rejected under 35 U.S.C. §102(e) as being anticipated by *Roach.* While Applicants do not acquiesce with the particular rejections to these dependent claims, these rejections are now moot in view of the remarks made in connection with independent Claims 1, 15, 26, 31, and 35. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from *Roach.* Therefore, Applicants respectfully submit that dependent Claims 2-4, 6-14, 16-25, 27-29, and 32-34 are also in condition for allowance.

Claims 5 and 30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Roach* in view of U.S. Publication No. 2004/0109459 to *Madour* et al. (hereinafter *Madour*). Applicants respectfully traverse the rejection. According to MPEP §2142, to establish a prima facie case of obviousness under 35 U.S.C. §103:

1) there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;

2) there must be a reasonable expectation of success; and

3) the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The Applicants respectfully submit that the combination of *Roach* in view of *Madour* does not teach or suggest all of the limitations of Claims 5 and 30. Additionally, there is no motivation to combine *Roach* and *Madour* as suggested in the Office Action. As previously set forth above, *Roach* at least fails to teach or suggest creating routing instructions based on user presence information. The Office Action did not rely on *Madour* to provide a remedy for this deficiency, nor does *Madour* provide such a remedy. Therefore the combination of *Roach* and *Madour* does not teach or suggest the each and every claim limitation Claims 5 and 30. As a result, Applicants' respectfully submit that a prima facie case of obviousness has not been established and Claims 5 and 30 are in further condition for allowance

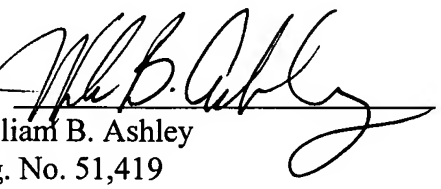
Additionally, there is on motivation in the references or in the knowledge generally available to one of ordinary skill in the art to combine *Roach* with *Madour*. The mere fact that references can be combined does not render the combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The proffered motivation in the Office Action that one skilled in the art would have combined *Roach* with *Madour* to "improve system flexibility" is conclusory, and the level of skill in the art cannot be relied upon to provide the suggestion to combine references (see, *e.g.*,. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). More particularly, to establish prima facie obviousness, the proffered motivation must provide a clear and particular showing, supported by actual evidence, to combine the references. *Teleflex, Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1334, 63 U.S.P.Q.2d 1374, 1387 (Fed. Cir. 2002). It is respectfully submitted that the proffered motivation provided in the Office Action does not rise to the level of clear and particular actual evidence.

Applicants submit that, even assuming *arguendo* that the references relied upon were individually known in the art, this is insufficient to establish a prima facie case of obviousness because there is no objective reason to combine *Roach* with *Madour*. *Roach* is silent as to using presence information for purposes of routing because *Roach* relies on Contact headers to route connections. Therefore *Roach* does not even recognize problems inherent in this approach, such as the inability to route different types of connection requests to different user agents based on the a user's presence status. Therefore, because *Roach* does not even recognize the use of presence-based filter criteria, there is no motivation to combine *Roach* with *Madour* as suggested in the Office Action. Applicants' therefore respectfully submit that Claims 5 and 30 are in condition for allowance.

Authorization is given to charge Deposit Account No. 50-0996 (NOKM.066PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned agent of record invites the Examiner to contact him at 952-854-2700 (x12) to discuss any issues related to this case.

Respectfully submitted,

Date: November 9, 2005

By: 
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